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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,923	08/29/2003	Charles E. Eller	0123324	2482

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EXAMINER

HARMON, CHRISTOPHER R

ART UNIT	PAPER NUMBER
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3721

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary

Application No.

10/652,923

Applicant(s)

ELLER ET AL.

Examiner

Christopher R. Harmon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-18 and 21-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26, 27 and 32-34 is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-18, 21-25 and 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 34 is objected to because of the following informalities: "the first size" in the penultimate line lacks proper antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 4, 7, 11, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Miura et al. (US 5,080,023).

Miura et al. disclose a container carrier system comprising pallet with bottom 31 and holes 35 defining a plurality of compartments; a plurality of pucks removably attached to the pallet. The pucks are considered removably held by a compartment when it is desired to restrict the space of a first-sized compartment by the addition of another puck (redefining the compartment size for a second-size container) see figures 9-11. Limitations such as "adapted to", "structured to be", etc. (claim 1, lines 4-5) present capability issues only. The system of claim 1 does not require any automation, it only requires a pallet structure capable of being used in a automated process. Note: a limitation directed to an intended use of an apparatus or a process requires a structural difference or a manipulative difference between the claimed invention and the prior art. See *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963); *In re Sinex*, 309

F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed.Cir. 1997).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 5, 6, 8, 9, 10, 12, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miura et al. (US 5,080,023) in view of Lasher et al (#5,771,657).

Miura et al. substantially show the claimed subject but do not show a pallet conveyor as well as the various known components in the prescription filling operation. Lasher teaches the basic concept of loading multiple pallets with prescription filling bottles on conveying system 21 to move the carriers for filling, carrier identification tags wherein each bottle is positioned in a carrier based on the tag information. Lasher discloses a robotic arm 79, which reads on a picker mechanism to pick up designated containers for loading. Lasher shows the concept of loading a plurality of containers on different pallets for loading containers on the carriers as well as unloading containers on the carriers.

It would have been obvious to provide the carrier means of Miura et al. with the various components in prescription filling of Lasher et al to fill prescriptions in bottles as

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is known in the art. Regarding the picker mechanism picking up pucks as opposed to the containers that are picked up by Lasher et al., the examiner notes that expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. See *ex parte Thibault*, 164 USPQ 666, 667 (Bd App. 1969). Furthermore, inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. In *re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963). Regarding the tag for storing information relating to the puck configuration, Lasher et al show the use of tags to store information relating to the carrier configuration and the examiner cites that inclusion of material worked upon by a structure being claimed does not impart patentability as discussed *supra*.

6. Claims 17, 18, 21-25, 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lasher (US 5,771,657) in view of Levey et al. (US 5,566,695) or Miura et al. (US 5,080,023).

Lasher et al teach the basic concept of loading multiple pallets with prescription filling bottles on conveying system 21 to move the carriers for filling, carrier identification tags wherein each bottle is positioned in a carrier based on the tag information. Lasher et al disclose a robotic arm 79, which reads on a picker mechanism to pick up designated containers for loading. Lasher shows the concept of loading a plurality of

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containers on different pallets for loading containers on the carriers as well as unloading containers on the carriers.

Lasher et al do not show the concept of having a carrier with multiple different pucks to accommodate different sized containers. However, Levey et al. and Miura et al. show the concept of having a pallet with various sized pucks to accommodate different sized containers.

Levey et al show a container carrier system comprising: a pallet structure as shown in fig 2, a plurality of pucks 33 that are removeably loaded onto the pallet to adapt a compartment to hold a plurality of container sizes as shown in figs 3a-3e. Levey et al disclose that a variety of different inserts can be provided to accommodate different container sizes to allow for different spacings between containers (Col 5 lines 23+). The pucks are loaded and unloaded on the pallets to change the pucks to accommodate different sized containers.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide Lasher with different pucks on a pallet as taught by either Levey et al. or Miura et al. to accommodate different sized containers for flexibility/adjustability in the filling operation. Both inventions to Levey et al. and Miura et al. are fully capable for use in an automated system such as that provided by Lasher et al.

Allowable Subject Matter

7. Claims 26-27 and 32-34 are allowed.

Response to Arguments

8. Applicant's arguments filed 12/7/06 have been fully considered but they are not persuasive.

Regarding the argument that Miura does not disclose loading/unloading the pucks on the pallet to adapt a compartment to hold a second container, Miura discloses spacing pucks for holding a plurality of containers of multiple sizes via holes 35. A first size and second sizes therefore are considered able to be accommodated by adding/modifying the arrangement of pucks on the pallets. Each compartment is therefore defined by the pucks and their relative placement to one another. Therefore a first size of container is able to be held in a first configuration and the addition of a puck of the configuration of 33 (figure 11) would then modify/adapt the compartment to hold a second container of a lesser size. The holes 35 in the pallets define the compartments and allow modification of the compartments via interchangeable puck placement.

Regarding the argument against Levey, the fact of a specified operation of the invention to Levey, ie. whether or not the a disclosed cleaning process involves multiple container sizes on a single pallet at the same time in one efficient cleaning operation, is inconsequential. The pallet system of Levey has the capability of providing the claimed configuration ie. multiple containers of differing sizes loaded at the same time.

Note again that while features of an apparatus may be recited either structurally or functionally, claims directed towards an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Schreiber*, 128 F.3d 1473-78, 44 USPQ2d 1429-32 (Fed.Cir. 1997) and *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed.Cir. 1990). Thus the pucks

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have the capability of being adapted as claimed and therefore are considered to read on the limitations as claimed.

Further note: the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language such as “adapted to”, “can be”, etc. that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

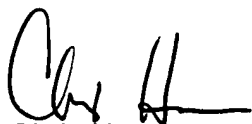
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Harmon whose telephone number is (571) 272-4461. The examiner can normally be reached on Monday-Friday from 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Chris H.', is positioned above the printed name and title.

Chris Harmon
Patent Examiner